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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,391	07/01/2003	Susan Hickey	100041-41143	1534

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/611,391

Applicant(s)

HICKEY ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 28, 29 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 28, 29, 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Stating in claim 8 that each sheet is joined to at least one adjacent sheet by a binding means.

### ***Claim Rejections - 35 USC § 112***

Claims 38 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 38 and 40, line 3, "said sheets" is confusing since it is not clear which sheets the applicant is referring to.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-14, 28, 29, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261).

G.B. '520 shows in figures 1-5 a mouse pad that includes a plurality of stacked sheets (block of sheets labeled 1) wherein each adjacent sheet is joined to another adjacent sheet along at least

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two separate edges. G.B. '520 discloses on page 1, three lines from the bottom, the idea of placing a calendar on each of the stacked sheets. G.B. '520 does not disclose whether the calendar portion has a time period of at least one week. Glass shows in figure 1 the idea of placing a calendar portion (month of January) that includes a time period of at least one week. In view of the teachings of Glass it would have been obvious to one in the art to modify G.B. '520 by placing a calendar portion having a time period of at least one week onto each of the sheets since this would allow an entire month to be displayed by a single sheet which would make the sheets more useful. In regard to claim 2, the sheets of G.B. '520 are made out of paper and are considered to have a charge of less than 10 volts when the mouse pad is grounded (a persons hand resting on the pad, the pad resting on a metal surface, etc.) and when it hasn't been used for an extended period of time the mouse pad would have little or no charge. In regard to claims 3,4, and 6, the sheets are generally rectangular with rounded corners and are adhered together with adhesive along three edges, see figures 4 and 5. In regard to claims 5 and 11, Glass discloses the idea of placing different calendar portions on each sheet, see page 1, column 2, lines 36-47. In regard to claim 7, the adhesive used is inherently weaker than the sheets since the sheets are separated from one another without damaging the sheets, see figure 5. In regard to claim 8, as broadly defined, the adhesive is considered to be the binding means. In regard to claim 10, the sheets of G.B. '520 are generally aligned. In regard to claims 12 and 13, Glass discloses that each sheet includes a month of the year in order, see page 1, column 2, lines 36-47. In regard to claim 14, G.B. '520 shows a backing pad (2). In regard to claim 28, the steps defined are the conventional steps that are followed in using a mouse pad, i.e. locating a computer mouse onto the mouse pad, moving said mouse along the pad to cause movement of a

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cursor on a computer display. In regard to claims 29 and 39, G.B. teaches the idea of removing a top sheet to expose another sheet, see page 2, fourth new paragraph which starts with "Referring". In regard to claim 39, the uppermost sheet would be removed from the stack of sheets at the end of the calendar period, this is the conventional manner in which calendars of the type taught by Glass are used. In regard to claims 38 and 40, G.B. '520 shows in figures 4-6 that one edge of the sheets does not include adhesive in order to allow a user to slide a finger between the sheets.

Claims 2,9,15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) as applied to claim 1 above and further in view of Scianna (U.S. Patent No. 5,997,995) and Savit (U.S. Patent No. 4,454,058) or the applicant's admitted prior art in the remarks section of the amendment filed on Nov. 19, 2004, page 11, lines 4-12.

In regard to claims 2,15, and 16, G.B. '520 in view of Glass disclose the applicant's basic inventive concept except for providing each sheet with an anti-static property or a reduced static electricity charge. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by

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adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent damage to electrical components and accumulation of dust and dirt. In regard to claim 9, G.B. '520 in view of Glass disclose the applicant's basic inventive concept except for making the resistivity of each sheet between 800 and about 3000 ohms. G.B. '520 fails to disclose the resistivity of the sheets but does disclose that the sheets are made from paper. Paper inherently has a high resistivity since it is an insulator. Paper would have a resistivity higher than the range specified by the applicant. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. Increasing the surface conductivity would reduce the resistivity of the paper sheets of G.B. '520. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets (which would reduce the resistivity) since this would reduce the amount of static electricity stored on the sheets and would provide a resistivity of between about 800 and about 3000 ohms. It is considered within one skilled in the art to vary the conductivity of the coating, and hence the resistivity, to reach the desired level. In regard to claims 16, 35, and 37, Savit and the applicant's admitted prior art disclose the idea of making the anti-static material in the form of a coating.

***Response to Amendment***

The declaration of Jacki J. Walters under 37 CFR 1.132 filed June 24, 2005 is insufficient to overcome the rejection of claims 1-16,28,29, and 38-40 based upon commercial success as set forth in the last Office action because: The applicant has failed to show that the claimed features were responsible for the commercial success of the calendars. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). Opinions as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. Conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight, See *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

***Response to Arguments***

The applicant argues that since the very purpose and thrust of the Great Britain patent is to disclose a mouse pad from which sheets can be removed as necessary once sufficient debris accumulates thereon, it is submitted that the proposed combination contravenes the purpose of the Great Britain patent. The examiner disagrees since the sheets would be changed on a regular basis (weekly or monthly depending upon the length of time of the calendar) so they would not have time to accumulate an excessive amount of dirt and debris.

The applicant argues that the subject matter of claim 39 would not be shown, given that the G.B. patent teaches removing the sheet once sufficient debris is accumulated thereon. The examiner disagrees since Glass shows in figure 1 a calendar that includes a plurality of calendar sheets in which the uppermost sheet is removed at the end of a calendar period. This is the conventional manner in which calendars of the type taught by Glass are used. When the G.B.

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patent is modified in view of Glass, as explained above in the 103 rejection, the uppermost sheet in the G.B. patent would be removed at the end of a calendar period.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Aug. 24, 2005